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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BERNDT *et al.*

Appl. No.: 09/595,420

Filed: June 15, 2000

For: **Apparatus for the Operation of a
Microfluidic Device**

Confirmation No.: 9071

Art Unit: 1743

Examiner: Jennine Brown

Atty Docket: 100/08410 (2052.0120001)

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Statement of the Substance of Examiner Interview

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

An Examiner Interview for the above-captioned application was conducted on June 9, 2003. Pursuant to the Interview Summary, which directs Applicants to file a statement of the substance of the interview within one month from the date of the interview if a reply to the last Office Action has already been filed, Applicants submit herewith such a statement.

Applicants and Applicants' representatives wish to thank Examiner Brown and Special Programs Examiner Skane-Tierney for according Applicants' representatives, Linda Alcorn and Andrew Filler, an interview on June 9, 2003. During the interview, claims 1-13 were discussed. In particular, the rejection under 35 U.S.C. § 102(f) and the double patenting rejection of the claims were discussed.

The claims were rejected under 35 U.S.C. § 102(f) because "[t]he invention claimed ... is fully encompassed by the specification and claims of a previously submitted application, 09/598,968." The claims were also provisionally rejected under the judicially-created

doctrine of double patenting over claims 1-14 and 18-25 of co-pending Application No. 09/598,968.

Applicants' representatives pointed out to the Examiner that the present application was filed in the U.S. on June 15, 2000, prior to the U.S. filing date of Application No. 09/598,968 of June 22, 2000. Further, both applications claim priority to applications that were filed on June 22, 1999. In the present case, the '420 application claims the benefit of Provisional U.S. Patent Appl. No. 60/140,215 filed on June 22, 1999. The interfering '968 application claims priority to a German priority application, also filed on June 22, 1999. As such, the '968 application is not a "previously submitted application" as referred to by the Examiner in the final Office Action.

Applicants' representative further discussed with Examiners Brown and Skane-Tierney that the dispute is one of inventorship and thus an interference to resolve the originality dispute is appropriate. Examiner Skane-Tierney advised Applicants' representative of the information that would be needed by the Board in order to declare an interference. In particular, she suggested that Applicants submit a declaration from inventor Kennedy, in which he declares that he contributed as an inventor to some of the claims pending in the '968 application. Applicants are currently preparing a Request for Interference and Declaration of Colin Kennedy and will submit these documents along with a RCE filing shortly.

In the meantime, if the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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Date: July 9, 2003

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